

REMARKS

STATUS OF APPLICATION

No claims have been added and claim 20 has been canceled in this paper. Accordingly, claims 1-19 and 21-29 are pending in the present application.

ALLOWABLE SUBJECT MATTER

The indication in the Office Action that claims 23, 24, and 26-29 are allowed is noted with appreciation.

The indication in the Office Action that claims 3 and 20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims is also noted with appreciation. Claim 3 has been so amended to independent form and claim 19, from which claim 20 depends, has been amended to include the limitations of claim 20. Accordingly, claims 3 and 19 are now in condition for allowance.

DRAWINGS

No objection to the drawings was indicated by the Examiner. Unless an indication is provided by the Office to the contrary, Applicant assumes the drawings to be acceptable.

35 USC § 102 REJECTIONS

Claims 1, 2, 7-9, 13-15, and 19, are allowable over US 2,597,554

Claims 1, 2, 7-9, 13-15, and 19, stand rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent 2,597,554 to West ("the West patent"). This rejection is respectfully traversed for the reasons set forth below.

Claim 1, as amended herein, requires that “the first gravel pack section imposes a substantially radial flow restriction that is different at a heel end of a horizontal wellbore from a substantially radial flow restriction at a toe end of a horizontal wellbore imposed by the second gravel pack section.” An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim.¹ The West patent, however, fails to disclose any use of gravel pack sections in a horizontal wellbore. Accordingly, the present invention, as set forth in claim 1, is allowable over the West patent.

Claims 2 and 7-9 depend from claim 1. Accordingly, the remarks provided above concerning claim 1 apply equally to claims 1 and 7-9.

Claim 13, as amended herein, requires “a gravel pack creating a progressively decreasing substantially radial flow restriction along its length.” The West patent teaches alternating layers of granular material 27, 31. The West patent, however, fails to suggest that the alternating layers create a progressively decreasing substantially radial flow restriction along the length of its gravel pack. The West patent fails to disclose that a modification of its gravel pack to produce such a configuration would even be desirable. Thus, the present invention, as set forth in claim 13, is allowable over the West patent.

Claims 14 and 15 depend from claim 13. Accordingly, the remarks provided above concerning claim 13 apply equally to claims 14 and 15.

Claim 19 has been amended to include the limitations of allowable claim 20. Accordingly, claim 19 is now in condition for allowance.

Therefore, it is respectfully requested that the rejection of claims 1, 2, 7-9, 13-15, and 19, under 35 U.S.C. § 102(b), as being anticipated by the West patent, be reconsidered and withdrawn.

¹ See *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

Claims 10 and 11 are allowable over USPAP 2002/0157837

The rejection of claims 10 and 11 under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent Application No. 2002/0157837 (“the Bode application”), is respectfully traversed for the reasons set forth below.

Claim 10 requires that each screen section of a production tubular comprises a flow restriction element selected from the group comprising sand packed sections within the screens, wire mesh packed sections within the screens and holes in a base pipe. The Office relies on the Bode application to teach “using a wellbore screen.”² The Office then alleges that the present specification discloses certain screen types are “well known in the art”, and that the screens of the Bode application could be any of these types of screens.³

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” (emphasis added).⁴ The Office, however, relies on two references (*i.e.*, the Bode application and the present specification) to teach the claimed configuration. Multiple references are proper in a 102 rejection only proper when the extra references are cited to:

- (A) Prove the primary reference contains an “enabled disclosure;”
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.⁵

In this rejection, however, the Office is using a combination of two references to teach the claimed invention. Such a rejection is improper and should be withdrawn.

² See page 5, line 12, of the present Office Action.

³ See page 5, lines 13-15, of the present Office Action.

⁴ See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁵ See MPEP 2131.01.

Claim 11 depends from claim 10. Therefore, the remarks provided above concerning claim 10 apply equally to claim 11.

Accordingly, it is respectfully requested that the rejection of claims 10 and 11 under 35 U.S.C. § 102(e), as being anticipated by the Bode application, be reconsidered and withdrawn.

35 USC § 103 REJECTIONS

Claims 4-6, 16-18, 21, 22, and 25, are allowable over the West patent in view of the Bode application

Claims 4-6, 16-18, 21, 22, and 25, stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the West patent in view of the Bode application. This rejection is respectfully traversed for the reasons set forth below.

Each of claims 4-6, as they depend from claim 1, requires that “the first gravel pack section imposes a substantially radial flow restriction that is different at a heel end of a horizontal wellbore from a substantially radial flow restriction at a toe end of a horizontal wellbore imposed by the second gravel pack section.” In an obviousness situation, the prior art must disclose each and every element of the claimed invention, and any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.⁶ Neither the West patent nor the Bode application disclose or suggest such a gravel pack configuration. Therefore, the present invention, as set forth in claims 4-6, is allowable over the West patent in view of the Bode application.

Claim 16, as it depends from claim 13, requires “a gravel pack creating a progressively decreasing substantially radial flow restriction along its length.” Neither the West patent nor the

⁶ See *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002).

Bode application disclose or suggest such a gravel pack configuration. Therefore, the present invention, as set forth in claim 16, is allowable over the West patent in view of the Bode application.

Claims 17 and 18 depend from claim 16 and are allowable for at least the same reasons set forth above concerning claim 16.

Claim 21 and 22 stand rejected; however, they depend from allowable claim 19 (discussed above). Accordingly, claims 21 and 22 are allowable.

Claim 25, as amended herein, recites a method in which the first and second gravel pack sections are "capable of imposing different flow restrictions at a heel end and at a toe end of a horizontal wellbore." Neither the West patent nor the Bode application disclose or suggest such a gravel pack configuration. Therefore, the present invention, as set forth in claim 25, is allowable over the West patent in view of the Bode application.

It is, therefore, respectfully requested that the rejection of claims 4-6, 16-18, 21, 22, and 25, under 35 U.S.C. § 103(a), as being unpatentable over the West patent in view of the Bode application, be reconsidered and withdrawn.

Claim 12 is allowable over the Bode application in view of the West patent

Claim 12 stands rejected under 35 U.S.C. § 103(a), as being unpatentable over the Bode application in view of the West patent. The rejection of claim 12 is respectfully traversed for the reasons set forth below.

In an obviousness situation, the prior art must disclose each and every element of the claimed invention. Neither the Bode application nor the West patent disclose or suggest a gravel pack having a progressively decreasing substantially radial flow restriction along its length, as

required by amended claim 12. Accordingly, claim 12 is allowable over the Bode application in view of the West patent.

Therefore, it is respectfully requested that the rejection of claim 12 under 35 U.S.C. § 103(a), as being unpatentable over the Bode application in view of the West patent, be reconsidered and withdrawn.

CONCLUSION

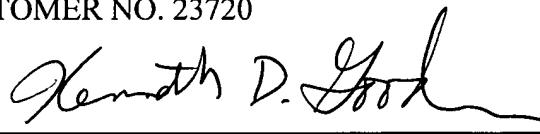
Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact Daren C. Davis at (817) 578-8616 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON, P.C.
CUSTOMER NO. 23720

Date: April 21, 2004

By: _____



Kenneth D. Goodman, Reg. No. 30,460
10333 Richmond, Suite 1100
Houston, Texas 77042
(713) 934-7000
(713) 934-7011 (facsimile)
AGENT FOR APPLICANT(S)